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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,779	12/14/2001	Scott R. Swix	36968.265393 (BS01377)	9532
7590	11/21/2005		EXAMINER	
Scoot Zimmerman P O Box 3822 Cary, NC 27519			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,779

Applicant(s)

SWIX ET AL.

Examiner

John Van Bramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/02 1/05 10/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed December 14, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specifically, the Application Numbers listed on sheet 3 of 6 in the IDS mailed on October 31, 2005 are not published material and therefore require a copy to be filed. Alternatively, if there is a PGPUB number associated with the listed Application Numbers then correcting the IDS statement to include the PGPUB number instead of the Application Number would be sufficient corrective action.

Specification

2. The disclosure is objected to because of the following informalities: The specification states that "U.S. Pat No. 4,556,030 issued to Nickerson, et al., discloses a data storage and transmission system for accumulating and transmitting data from a plurality of remote T.V. panelist locations to a central location", however U.S. Pat No. 4,556,030 is issued to Aono and was issued for the "Control Arrangement for Internal

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Combustion Engine". The examiner assumes you intended to cite U.S. Pat No.

4,566,030 and the case has been prosecuted with this correction.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-10, 12-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (U.S. Patent Number: 5,848,397).

Claim 1: Marsh discloses an advertisement management method, comprising:

a. Designating an advertisement time slot for a first advertisement.

(Col 7, lines 40-52)

b. Inserting the first advertisement into the advertisement time slot.

Col 7, lines 40-52)

c. Categorizing the first advertisement as one of: an overrideable advertisement and a non-overrideable advertisement. (Col 12, lines 7-64)

d. Receiving a request from a second advertiser to replace the first advertisement with a second advertisement. (Col 9, lines 65 through Col 10 line 20)

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e. Determining whether the first advertisement is categorized as an overrideable advertisement. (Col 12, lines 7-64)

f. If it is determined that the first advertisement is categorized as an overrideable advertisement, replacing the first advertisement with the second advertisement. (Col 12, lines 7-64)

Claim 3: Marsh discloses the method of claim 1, wherein the first advertisement is priced at a lower cost than a non-overrideable advertisement. (Wherein the first advertisement is a public service advertisement with a NO_PRIORITY status)(Col 8, lines 49-62 and Col 13, lines 8-39)

Claim 4: Marsh discloses the method of claim 1, wherein the request to replace the first advertisement with the second advertisement is based upon data obtained using ratings system technology that tracks program viewing activities for the purpose of identifying most-valuable and least-valuable potential customers. (Col 15, line 31 through Col 16, line 12)

Claim 5: Marsh discloses the method of claim 1, wherein the first and second advertisements are broadcast to the potential consumers via a broadcast transmission. (Col 8, lines 47-62)

Claim 6: Marsh discloses the method of claim 5, wherein the broadcast transmission comprises at least one of: a television broadcast, a radio broadcast, and a broadcast sent over the Internet and received on a personal computer. (Col 8, lines 47-62)

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Claim 7: Marsh discloses the method of claim 6, wherein the broadcast sent over the Internet further comprises an advertisement displayed as a web-page. (Col 7, line 66 through Col 8, line 24; and Col 8, lines 46-62)

Claim 8: Marsh discloses the method of claim 1, wherein the request to replace the first advertisement with the second advertisement is based upon data obtained using marketing tools comprising at least one of: rating systems that track program viewing activities by sampling a plurality of households and estimating the number of viewers of the programs using viewing activity data, focus groups that study the effectiveness of different types of advertisements, and product sales reports. (Col 15, line 31 through Col 16, line 1)

Claim 9: Marsh discloses an advertisement management method, comprising:

- a. Designating an advertisement time slot for a first advertisement.
(Col 7, lines 40-52)
- b. Inserting the first advertisement into the advertisement time slot.
(Col 7, lines 40-52)
- c. Categorizing the first advertisement as one of: an overrideable advertisement and a non-overrideable advertisement. (Col 12, lines 7-64)
- d. Receiving a request from a second advertiser to replace the first advertisement with a second advertisement via an interactive server. (Col 7, lines 40-52)

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e. Determining whether the first advertisement is categorized as an overrideable advertisement. (Col 12, lines 7-64)

f. If it is determined that the first advertisement is categorized as an override advertisement, replacing the first advertisement with the second advertisement via the interactive server. (Col 12, lines 7-64)

Claim 10: Marsh discloses the method of claim 9, wherein the interactive server is further operable for storing, managing, receiving, and responding to the first and second advertisement via the interactive server. (Col 6, lines 35-48)

Claim 12: Marsh discloses the method of claim 9, wherein the overrideable first advertisement is priced at a lower cost than a non-overrideable first advertisement. (Wherein the first advertisement is a public service advertisement with a NO_PRIORITY status) (Col 8, lines 49-62, and Col 13, lines 8-39)

Claim 13: Marsh discloses the method of claim 9, wherein the request to replace the first advertisement with the second advertisement is based upon data obtained using ratings system technology that tracks program viewing activities for the purpose of identifying most-valuable and least-valuable potential customers. (Col 15, line 31 through Col 16, line 12)

Claim 14: Marsh discloses the method of claim 9 wherein the first and second advertisements are broadcast to the potential consumers via a broadcast transmission. (Col 8, lines 47-62)

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Claim 15: Marsh discloses the method of claim 14, wherein the broadcast transmission comprises at least one of: a television broadcast, a radio broadcast, and a broadcast sent over the Internet and received on a personal computer. (Col 8, lines 47-62)

Claim 16: Marsh discloses the method of claim 15, wherein the broadcast send over the Internet further comprises an advertisement displayed as a web-page. (Col 7, line 66 through Col 8, line 24; and Col 8, lines 46-62)

Claim 17: Marsh discloses a system for managing advertisement programming, comprising:

- a. An advertisement time slot occupied by a first advertisement. (Col 7, lines 40-52)
- b. A second advertisement. (Col 7, lines 40-52)
- c. An interactive server of a network content provider, wherein the interactive server is operable for replacing the first advertisement with the second advertisement. (Col 7, line 1 through Col 8 line 30)

Claim 18: Marsh discloses the system of claim 17, wherein the interactive server is further operable for storing, managing, receiving, and responding to requests regarding the first and second advertisements. (Col 7, line 53 through Col 8, line 30)

Claim 20: Marsh discloses the system of claim 17, wherein the network content provider comprises at least one of: a television network, a radio network, and a computer network. (Col 5, lines 28-35)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al (U.S. Patent Number: 5,848,397).

Claim 2: Marsh discloses the method of claim 1, wherein various advertisements are given a priority status (e.g., HIGH, MEDIUM, LOW, NO) wherein the NO priority assignment can be a public service advertisements which are typically cost free (Col 8, lines 49-62 and Col 13, lines 8-39). However, Marsh does not explicitly state that these priorities are based upon the cost of an advertisement. Marsh also discloses a mechanism for sorting the advertisements that fall within each assigned priority queue (Col 12, lines 7-64). The sorting criteria includes such factors as length of time the advertisement is to run and the number of exposures an advertisement is to receive. These criteria have historically been linked with the cost of an advertisement. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the second advertiser to pay a premium to replace the first advertisement with the second advertisement. One would have been motivated to set up a priority status based upon cost in order to allow the advertisement time slot provider the ability to maximize revenue for a given time slot based upon market demands.

Claim 11: Marsh discloses the method of claim 9, wherein various advertisements are given a priority status (e.g., HIGH, MEDIUM, LOW, NO) wherein the NO priority assignment can be a public service advertisements which are typically cost free (Col 8, lines 49-62 and Col 13, lines 8-39). However, Marsh does not explicitly state that these priorities are based upon the cost of an advertisement. Marsh also discloses a mechanism for sorting the advertisements that fall within each assigned priority queue (Col 12, lines 7-64). The sorting criteria includes such factors as length of time the advertisement is to run and the number of exposures an advertisement is to receive. These criteria have historically been linked with the cost of an advertisement. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the second advertiser to pay a premium to replace the first advertisement with the second advertisement. One would have been motivated to set up a priority status based upon cost in order to allow the advertisement time slot provider the ability to maximize revenue for a given time slot based upon market demands.

Claim 19: Marsh discloses the system of claim 17, wherein various advertisements are given a priority status (e.g., HIGH, MEDIUM, LOW, NO) wherein the NO priority assignment can be a public service advertisements which are typically cost free (Col 8, lines 49-62 and Col 13, lines 8-39). However, Marsh does not explicitly state that these priorities are based upon the cost of an advertisement. Marsh also discloses a mechanism for sorting the advertisements that fall within each assigned priority queue (Col 12, lines 7-64). The sorting criteria includes such factors as length of

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time the advertisement is to run and the number of exposures an advertisement is to receive. These criteria have historically been linked with the cost of an advertisement. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the second advertiser to pay a premium to replace the first advertisement with the second advertisement. One would have been motivated to set up a priority status based upon cost in order to allow the advertisement time slot provider the ability to maximize revenue for a given time slot based upon market demands.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Aggarwal et al ("A Framework for the Optimizing of WWW Advertising" Proceedings of the International IFIP/GI Working Conference on Trends in Distributed Systems for Electronic Commerce, Pages: 1 – 10, Year of Publication: 1998) which discusses optimizing the management of advertisements.
- b. Logan et al. (U.S. Patent Number: 5,721,827) which discusses a personalized information delivery system utilizing an audio platform.
- c. Baron et al. (U.S. Patent Number: 5,809,481) which discloses a tag bearing advertisement methodology.

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d. Radziewicz et al. (U.S. Patent Number: 5,854,897) which discloses another advertisement management system.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


jvb

November 7, 2005


JAMES W. MYHRE
PRIMARY EXAMINER